

### **REMARKS**

No claims have been allowed.

Claim 2 was objected to as being dependent on itself. That has been corrected and claim 2 is now dependent on claim 1.

Objections were made to the Abstract and the language has now been amended accordingly.

In addition, it was noted that the last word of the Title was incorrect and that has been corrected as well.

#### **I. The Rejections**

Independent claims 1 and 19, as well as dependent claims 2 and 4 (each dependent on claim 1) and 11 (dependent on claim 9) have been rejected under 35 U.S.C. § 102 (b) as anticipated by Desai (US 6,034,746).

Independent claim 9, as well as dependent claims 10 and 16 – 18 (each dependent on claim 9) and 3 (dependent on claim 1), and 20 (now dependent on claim 19) have been rejected under 35 U.S.C. § 103 (a) as unpatentable (obvious) over Desai in view of Sakamoto et al. (US 6,026,164).

#### **2. The Response**

With respect to dependent claim 11, it logically cannot be said that claim 11 is anticipated by Desai while its less restricted parent, claim 9, is said to be obvious in view of the combination of Desai and Sakamoto et al. The rejection of claim 11 under §102 should be withdrawn. Furthermore, it will be pointed out below why claim 9 is allowable over the cited combination of references.

With respect to Desai, it can readily be seen that this patent is concerned with inserting data such as a commercial into a digital datastream.

However, Desai goes about doing this task in a significantly different way than Applicant's claimed invention. In Desai, (see col. 5, lines 1-4), it is stated:

"To allow for insertion of commercial data, the distributor of a movie provides control information, including a commercial insert file, and one or more data files, along with the movie."

Furthermore, Desai (col. 5, line 23) states:

"When a client (e.g. client 10 in FIG. 1) requests an audio/video asset, a play list is typically constructed by a controller (e.g., controller 16 in FIG. 1). The play list is used to control which data is sent, and in what order the data is sent, from data pump 18 to client 10. The commercial insert file and the data files allow a play list to be constructed such that the movie is played with commercials."

It should be apparent from the foregoing that Desai discloses neither

simultaneously receiving a first video stream and a second video stream, the latter comprising encoded data representing a second video program of a second display resolution lower than said first display resolution nor

seamlessly incorporating said first video program encoded data and said second video program data and said identification information into packetized data;

as presently claimed in independent apparatus claim 1 and claims 2 – 8, dependent thereon.

It is noted that the language "simultaneous(ly)" is found near the end of paragraph 0018 of the present specification.

Similar language has also been incorporated into independent method claim 9 and independent method claim 19 by this amendment.

Therefore, claims 9 – 18, as well as 19 and 20 are submitted to distinguish over Desai as well.

The secondary reference, Sakamoto et al., does not disclose any of the features of the present claims pointed out above. It should be noted that Sakamoto describes significantly different arrangements for transmitting and decoding a plurality of entire encrypted datastreams, which is not relevant to the presently claimed invention.

#### Proper Basis for Rejections Under 35 U.S.C. § 103(a)

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings of a plurality of references. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's own disclosure. In re Vaeck, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The examiner bears the burden of establishing a prima facie case of obviousness and "can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988, emphasis added). To support a conclusion that a claimed combination is obvious, either: (a) the references must expressly or impliedly suggest the claimed combination to one of ordinary skill in the art, or (b) the examiner must present a convincing line of reasoning as to why a person of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

#### All § 103(a) Rejections of Claims Are Traversed

The action does not make out a prima facie case of obviousness with respect to any of the pending claims..

There is clearly no objective teaching in either cited reference that would lead an individual of ordinary skill to somehow combine them to arrive at Applicant's claimed combinations. Under the law applied in obviousness rejections, the Examiner's rejection should be withdrawn (*In re Fine*, supra).

It is respectfully submitted that neither of the cited references satisfies the requirement of teaching or suggesting modifying either reference in any manner to arrive at the claimed combinations of apparatus and method elements. Furthermore, it is respectfully submitted that a prima facie case of obviousness is not made out on the basis of these references since there is nothing which would suggest or motivate anyone to modify the references in a way which would be consistent with the present claims. Finally, there would be no reasonable expectation of success for any purpose by modifying these references.

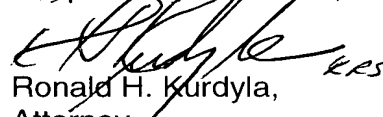
It is respectfully submitted that the § 103(a) rejection of the claims should be withdrawn and those claims, as amended should be allowed.

### 3. Conclusion

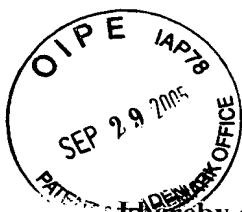
Independent claims 1, 9 and 19 each include distinguishing features as pointed out above which are not found in the cited references or any combination of those references.

In view of the foregoing Remarks, reconsideration and withdrawal of all of the rejections and allowance of all pending claims 1 – 20 are respectfully requested.

Respectfully submitted,

  
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